

## REMARKS

Claims 1, 2, 6 and 8 were rejected in this First Office Action. In response, claims 1, 2, 6 and 8 were amended, and claim 11 was added. Accordingly, claims 1, 2, 6, 8 and 11 are pending in this Application.

### Response to Rejection under 35 USC 112:

The Examiner rejected claims 1, 2, 6 and 8 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctively claim the subject matter which applicant regards as the invention. Specifically, the Examiner stated that it is not understood to that the structural limitations are of a plastic bag. The Examiner has interpreted a "plastic bag" in its broadest sense to the equivalent to a laminate covering sealed around the edges.

In response, applicant is deleting the language "plastic bag" from claim 1. In claim 8, the language "plastic bag" is still used. However, applicant respectfully submits that applicant is allowed to use his own lexicon because the structure of "plastic bag" is well defined by figures 4A and 4B and the related description in the specification.

### Response to Claim Rejection under 35 USC 103:

The Examiner rejected claims 1, 2, 6 and 8 under 35 USC 103(a) as being unpatentable over Machnikowski (4,024,832) in view of Weinberg (5,515,8090). Applicant respectfully submits that claims 1, 2, 6 and 8, as amended, have overcome this rejection.

Specifically, claim 1, as amended, recites a bookmark which contains the following limitations:

wherein the bookmark body (20) has a protective surface (21) on which the bookmark clip is mounted, has a bendable folding surface (23)

extending from the protective surface (21), *and has a folding sheet (22) extending from the folding surface (23)*, thereby when the bendable folding surface (23) is bent over one or more pages of the book, *the folding sheet (22) is inserted between two inner pages of the book.* (emphasis added)

By contrast, Machnikonwski does not disclose or suggest *a folding sheet (22)*, as required by claim 1. In addition, the combination of Machnikonwski and Weinberg does not teach or suggest having “*a folding sheet (22) extending from the folding surface (23)*, thereby when the bendable folding surface (23) is bent over one or more pages of the book, *the folding sheet (22) is inserted between two inner pages of the book.*”

In fact, Machnikonwski teaches away from having such a folding sheet (22). Specifically, Machnikonwski recites an embodiment of a bookmark including a first section 26 and a second section 28 (see figure 1 of Machnikonwski). According to Machnikonwski, “... the remainder of the first section 26 can be slipped over or inserted on to the edge of one or more pages 32 of a book while the second section extends from the pages and also the cover 34 of the book so that this section of the bookmark is readily visible, even with the book closed.” (See lines 58-63 in column 2 of Machnikonwski).

In addition, Machnikonwski recites another embodiment of a bookmark including a first section 98 and a second section 100 (see figure 8 of Machnikonwski). According to Machnikonwski, “The remainder of the sheet forms a first section 98 and an always exposed or visible second section 100 adjacent to the fixed end of the tongue. (See lines 46-48 in column 4 of Machnikonwski). Furthermore, Machnikonwski describes “The section 100 of the marker extends out beyond the cover 102 of the manuscript so as to be visible, even if it is closed, to catch a person’s attention.” (see lines 59-62 in column 4 of Machnikonwski). In summery, Machnikonwski has no motivation or intention *to insert its second section of the bookmark between two inner pages of a book.*


Accordingly, claim 1, as amended, is patentable under 35 USC 103(a) over Machnikowski in view of Weinberg. Claims 2, 6, 8 and 11 depend from claim 1 and contain additional features and limitations. Therefore, they are additionally allowable under 35 USC 103(a) over Machnikowski in view of Weinberg.

Conclusion:

In view of the forgoing, all pending claims (claims 1, 2, 6, 8 and 11) are deemed in allowable condition. Allowance for all pending claims is respectfully requested.

The Commissioner is hereby authorized to charge any additional fee to Deposit Account 50-2125. A duplicate of this sheet is enclosed.

Respectfully submitted,



Ying Tuo  
Registration No.: 38,789  
Attorney for Applicant

Date: 3/28/2004

Ying Tuo  
P.O. Box 14158  
Fremont, CA 94539

### **Claims Marked-up to Indicate Changes**

1. (four time amended) A bookmark comprising:
  - a bookmark body (20) including a bookmark clip (24) that is mounted on the bookmark body (20) to clamp [a book] the cover of a book or at least one content page of [a] the book;
  - wherein the bookmark clip (24) has a width that is substantially equal to that of the bookmark body (20);
  - wherein the bookmark body (20) has a [body] protective surface (21) [and is bendable, has a protection surface] on which the bookmark clip (24) is mounted, [and] has a bendable folding surface (23) extending from the protective surface (21), and has a folding sheet (22) extending from the folding surface (23), thereby when bendable folding surface (23) is bent over one or more pages of the book, the folding sheet (22) is [sheet capable of being] inserted [into] between two inner pages of the book[;
  - wherein the bookmark clip is adhesively mounted on the bookmark body; and
  - wherein the bookmark body is a plastic bag which contains the protective surface and the folding sheet disposed at two ends of the plastic bag respectively, there is a gap between the protective surface and the folding sheet, and a plastic bag portion within the gap is bendable].
2. (twice amended) The bookmark according to claim 1, wherein the bookmark clip (24) is made of plastic, metal or other resilient material.
3. (previously deleted)
4. (previously deleted)
5. (previously deleted).
6. (three amended) The bookmark according to claim 1, wherein the [body] folding surface (23) includes a plurality of parallel folding lines or a groove.

7. (previously deleted)

8. (three time amended) The bookmark according to claim 1, wherein [the protective surface and the folding sheet are disposed inside of the plastic bag by hot melting] the bookmark body is a plastic bag (40), wherein the protective surface (41) is disposed at one end of the plastic bag (40), the folding sheet (42) is disposed at the other end of the plastic bag (40), and the folding surface (43) is formed on the plastic bag (40) between the protective surface (41) and the folding sheet (42).

9. (previously deleted)

10. (previously deleted)

11. (added) The bookmark according to claim 1, wherein the bookmark clip is adhesively mounted on the bookmark body (20).

## **Claims Following Entry of the Present Amendment**

1. A bookmark comprising:

a bookmark body (20) including a bookmark clip (24) that is mounted on the bookmark body (20) to clamp the cover of a book or at least one content page of the book;

wherein the bookmark clip (24) has a width that is substantially equal to that of the bookmark body (20);

wherein the bookmark body (20) has a protective surface (21) on which the bookmark clip (24) is mounted, has a bendable folding surface (23) extending from the protective surface (21), and has a folding sheet (22) extending from the folding surface (23), thereby when the bendable folding surface (23) is bent over one or more pages of the book, the folding sheet (22) is inserted between two inner pages of the book.

2. The bookmark according to claim 1, wherein the bookmark clip (24) is made of plastic, metal or other resident material.

6. The bookmark according to claim 1, wherein the folding surface (23) includes a plurality of parallel folding lines or a groove.

8. The bookmark according to claim 1, wherein the bookmark body is a plastic bag (40), wherein the protective surface (41) is disposed at one end of the plastic bag (40), the folding sheet (42) is disposed at the other end of the plastic bag (40), and the folding surface (43) is formed on the plastic bag (40) between the protective surface (41) and the folding sheet (42).

11. The bookmark according to claim 1, wherein the bookmark clip (24) is adhesively mounted on the bookmark body (20).